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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,457	10/16/2001	Nicholas Moffat Irving-Antillon	104135-0002	5915

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EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,457

Applicant(s)

IRVING-ANTILLON, NICHOLAS
MOFFAT

Examiner

Rob Rábago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to catalysts, classified in class 502, subclass 155.
- II. Claims 8-22, drawn to processes of polymerization, classified in class 526, subclass 172.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the catalyst would be useful in hydrogenation, isomerization, oligomerization, etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Robert Rigby on 9/17/2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Guatemala on 10/18/2000. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 4 the limitation "one to twenty carbon atoms" cannot be found in the specification.

Claim Objections

4. Claim 1 is objected to on the grounds that the complex includes lower case "y" while the definition list includes only upper case "Y". The claim should be amended for internal consistency and to remove any question regarding the significance of the mismatched case.

5. While not a point of objection or rejection, the following is noted with respect to the meaning of the group HSR. Claim 1 describes $[ML_y(HSR)_n]^{+n}$ as a complex. Accordingly, the claims have been examined using the interpretation that the group HSR is a ligand group bound to M.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Pretzer et al. (US 4,447,557).

The reference shows in Examples II-V a catalyst comprising the product of combining cobalt acetylacetonate and a thiol in approximately equimolar proportions, including all claimed limitations. Although the reference has not specifically described the product as a thiol complex, it would be readily apparent to those of ordinary skill in the art that the thiol would complex with cobalt to form complexes within the broad scope of claim 1 because of the available empty orbitals of cobalt and the strongly electron-donative nature of the thiol. Sound scientific basis has been shown which indicates that the cited reference disclosure inherently specifies the claimed complex, and therefore the burden of proof is shifted to applicants to show that the components described in the applied reference examples would not form a complex within the claimed scope.

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackenzie et al. (US 6,103,658).

The reference discloses diimine-based catalysts also containing sulfur sites, and the specifically named species as set forth in the numerous sulfur-containing working examples contain all claimed limitations of at least independent claim 1 except for the presence of at least one HSR group. While the reference examples have focused extensively on nickel complexes containing a dithiane component wherein the two sulfur sites are bridged, the reference provides extensive disclosure that one or both of the sulfur sites may be substituted with hydrogen (described as groups R² and R³ in the reference) resulting in the instantly claimed HSR ligand-containing catalyst, and that the transition metal may be cobalt. Specifically, structures V and IV disclose such alternative species at col. 15, line 60 through col. 16, line 31 (particularly col. 16, lines 22 and 31), and col. 23, lines 35-65 (particularly lines 52 and 61), with analogous disclosure repeated in patented claims 2, 5, 6, 14, 37 and 41. One of ordinary skill in the art would be motivated to obtain a catalyst comprising at least one HSR ligand as in instant claims 1-5, also comprising cobalt as in claims 2 and 3, because patentee has

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disclosed these alternative structures as useful catalysts, with reasonable success expected.

Allowable Subject Matter

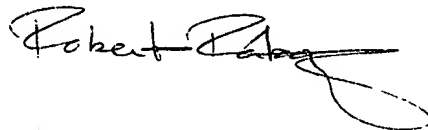
10. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rábago whose telephone number is (703) 308-4347. The examiner can normally be reached on Monday - Friday from 7:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Rob Rábago
Examiner
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RR
February 15, 2003